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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/575,506	05/12/2008	Andrea Montani	33033-1081	3913
45263	7590	05/26/2010		
MITCHELL P. BROOK LUCE, FORWARD, HAMILTON & SCRIPPS LLP 600 West Broadway, Suite 2600 SAN DIEGO, CA 92101			EXAMINER MOMPER, ANNA M	
			ART UNIT 3657	PAPER NUMBER
			MAIL DATE 05/26/2010	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/575,506

Applicant(s)

MONTANI ET AL.

Examiner

ANNA MOMPER

Art Unit

3657

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 4/13/2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/22)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. Amendment to the claims received 3/16/2010 has been entered. Claims 7-8 have been added.

### ***Response to Arguments***

2. Applicant's arguments filed 3/16/2010 have been fully considered but they are not persuasive.
3. Applicant argues with respect to claim 1 that Ali fails to disclose a mobile element that is mobile during functioning and that the mounting plate is fixed to the engine. The examiner disagrees. The examiner notes that the claim drawn to the tensioner as an apparatus does not positively require that the tensioner be mounted in an engine or anywhere else, further the Recitation "during functioning" provides a broad limitation that does not require that the tensioner be installed and operatively providing tensioning on a belt run. For at least this reason, the tensioner of Ali recites the elements of the claimed invention. Further, while not argued by applicant, claim 2 requires the mobile element is hinged about a fixed axis, Ali discloses a fixing point on the mounting plate 50, shown in Fig. 6, while a bolt or other fixing device tightened sufficiently to clamp the mounting plate to an engine or other existing structure would provide a fixed and stationary mount, that the locating of the bolt or fixing device in the hole provided in the mounting member but not tightened to clamp the belt, would provide the fixed axis allowing the mounting plate to rotate about the hinged axis.

***Drawings***

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "44" has been used to designate both "second central end portion" and "external side".
5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "43" has been used to designate both "first peripheral end portion" and "contrast wall".
6. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 24, 25
7. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 7-8 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 7 recites "one or more belts". This constitutes new matter as the specification as originally filed only discloses and provides support for a single belt.
10. Claims 7-8 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 7 recites "a spring acting on said arms to generate a tensioning force". This claim is not enabled as the specification discloses the spring element 17 being constrained via projecting element 20 of the mobile element and via a groove 46 on the shaft carried by the head portion 47 which is integral with arm 13. The specification further discloses the arm 14 having a second through hole 40 which couples the arm in such a way that it is able to rotate about pin 37. Therefore disclosing the arm 13 is free to rotate relative to arm 14. Further if the spring cooperates between arm 14 and the mobile element it is unclear how as to how the spring is capable of "acting on said arms to generate a tensioning force". For this reason the claim is not enabled. While the specification discloses "a spiral spring 17, which co-operates with the mobile element and with one of

the two arms, or else with arms 13, 14 for loading the belt 10 and generating the tensioning force necessary for operation of the drive" the mere disclosure that the spring could co-operate with both arms is not sufficient to provide an enabling disclosure and that disclosure of the physical structure that allows the spring to co-operate with both arms is required.

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Ali et al. (20020039944).

As per claim 1, Ali et al. teach a tensioner (28) for a belt (30) of a drive (10) of a motor vehicle, comprising: a first and a second idle pulleys (16, 26) designed to co-operate with respective belt runs of said belt (30); a first arm (42) bearing said first idle pulley (16); a second arm (44) hinged to said first arm about a mobile axis (axis of 40) and bearing said second pulley (26); and elastic means (38) acting at least indirectly on said arms for tensioning said belt, said tensioner being characterized in that said first arm is hinged about said mobile axis and by comprising a mobile element (50) distinct

from said first (42) and said second arm (44) and mobile during functioning, said mobile axis (axis of 40) being carried by said mobile element (50) (Fig. 6).

As per claim 2, Ali et al. teach said mobile element (50) is hinged about a fixed axis (Fig. 6, [0044]).

As per claim 3, Ali et al. teach said elastic means (38) are carried on said mobile element (50) (Fig. 4).

As per claim 4, Ali et al. teach said elastic means (38) co-operate with one of said arms (42, 44) and with said mobile element (50) ([0036], [0043], Fig. 5).

As per claim 5, Ali et al. teach said elastic means (38) act between said arms (42, 44)(Fig. 4).

As per claim 6, Ali et al. teach arrest elements (38, 46, 48) co-operating with said arms (42, 44) for limiting opening of said arms with respect to one another ([0045]).

13. Claim 7 is rejected under 35 U.S.C. 102(e) as being anticipated by Oliver et al. (US 2003/0216203 A1).

As per claim 7, Oliver et al. discloses a belt drive tensioner (114) comprising:  
first (127) and second pulleys (126) operating with one or more belts (112) running over the pulleys (Fig. 7);

a first arm (125) rotatably coupled to a mobile element (122) about a mobile axis (184), said first pulley (127) being mounted on the first arm (125, [0044]);

a second arm (124) rotatably coupled to said first arm (125) and to said mobile element (122) about the mobile axis (184), said second pulley (126) being mounted on the second arm (124); and

a spring (128) acting on said arms to generate a tensioning force ([0044]).

14. Claims 7-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Page et al. (US 4,768,997)

As per claim 7, Page et al. discloses a belt drive tensioner (250, Fig. 10) comprising:

first and second pulleys (258) operating with one or more belts (36') running over the pulleys (Fig. 10);

a first arm (254) rotatably coupled to a mobile element (102') about a mobile axis (256), said first pulley being mounted on the first arm (fig. 10, Fig. 11);

a second arm (252) rotatably coupled to said first arm (254) and to said mobile element (102') about the mobile axis (256), said second pulley being mounted on the second arm (Fig. 10, Fig. 11); and

a spring (262) acting on said arms to generate a tensioning force.

As per claim 8, Page et al. discloses the mobile element (102') comprises:

a first end portion rotatable about a fixed axis at a hinge (Fig. 10, first end portion connected to fixed hinge shown at top of Fig. 10); and

a second end portion opposite to the first end portion, the second end portion being rotatable about the mobile axis (256, Fig. 10).

### ***Conclusion***

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANNA MOMPER whose telephone number is (571)270-5788. The examiner can normally be reached on M-F 6:00-3:30 (First Friday Off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Siconolfi can be reached on (571) 272-7124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

am

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